

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

OCT. 16, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

International Computer Limited

v.

JRL Enterprises, Inc.

---

Opposition No. 91,912  
to application Serial No. 74/239,921  
filed on January 24, 1992

---

Thomas E. Smith of Lee, Mann, McWilliams, Sweeney & Ohlson  
for International Computers Limited.

Fred W. Hathaway of Burns, Doane, Swecker & Mathis for JRL  
Enterprises.

---

Before Simms, Walters and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

JRL Enterprises, Inc. has filed an application to  
register the mark ICL for "training system comprised of  
computer hardware and software for use as an educational

classroom aid and independent, self-testing and learning tool for students."<sup>1</sup>

International Computers Limited has filed an opposition to registration of the mark under Section 2(d) of the Trademark Act, 15 USC § 1052(d), on the ground of likelihood of confusion. Opposer alleges that applicant's goods are identical to the goods and services with which opposer uses the identical mark ICL. Opposer asserts ownership of registrations for the mark ICL<sup>2</sup> for use in connection with:

Computer hardware, i.e., series processors, terminals, and disc storage units in Class 9; and  
Computer programs recorded on machine-readable tapes, cards, or discs; publications containing specifications or descriptions of computer programs; and forms with visually readable program information recorded thereon in Class 16.<sup>3</sup>

Computer engineering services in Class 42.  
Computer programming services in Class 35.  
Training personnel of users of computers in the operation and/or programming of computers in Class 41.<sup>4</sup>

Applicant, in its answer, as amended, has denied the salient allegations of the notice of opposition and has set forth a counterclaim to cancel opposer's pleaded Registration No. 941,672 in whole or in part, on the basis

---

<sup>1</sup> Ser. No. 74/239,921, filed Jan. 24, 1992, based on a bona fide intent to use.

<sup>2</sup> While opposer alleged ownership of three additional registrations in the notice of opposition, these registrations have since been cancelled under Section 8, as admitted by opposer, and need not be considered.

<sup>3</sup> Reg. No. 967,021, issued Aug. 28, 1973; renewed Aug. 28, 1993.

<sup>4</sup> Reg. No. 941,672, issued Aug. 22, 1972; renewed Aug. 22, 1992.

of abandonment or nonuse,<sup>5</sup> and to cancel opposer's pleaded Registration No. 967,021 in part, on the basis of nonuse. In its counterclaim, applicant asserts that, although it maintains its denial of the likelihood of confusion, by cancellation or restriction of the goods and services in the pleaded registrations to the fields of actual use, the likelihood of confusion would be even further avoided.

The record consists of the files of the involved application and the two pleaded registrations; trial testimony taken by opposer with related exhibits; trial testimony taken by applicant; and certain responses of opposer to applicant's discovery requests and requests for admission, as well as documents produced by opposer and authenticated by means of requests for admission, all made of record by applicant's notice of reliance. Both parties filed briefs on the case, but no oral hearing was requested.

In the testimony of Jack O'Keefe, associate general counsel for ICL, Inc., a wholly-owned subsidiary of opposer, he describes the computer products and related software sold by opposer in the United States primarily for use in point-of-sale systems by retail and grocery store operations and for office automation by law firms and other large

---

<sup>5</sup> While applicant sets forth the grounds for cancellation in its pleadings as abandonment or nonuse, the actual basis alleged by applicant is that the services identified in this registration are intended primarily in support of opposer's goods and thus are not properly the subject of registration.

businesses. Mr. O'Keefe further outlines the services provided to its customers including computer engineering services, such as systems integration, computer programming to develop a custom software package for a specific customer's needs, and training in the use not only of opposer's hardware and software but also third-party hardware and software of the customer which may be integrated into the system. By means of exhibits introduced during his testimony, Mr. O'Keefe demonstrates the nature of the training systems developed by opposer to instruct customer personnel in a hands-on environment replicating the customer's particular system, which include training materials containing self-tests and exercises to allow the students to test their training at various stages.

Applicant introduced the testimony of its president, John R. Lee, to describe the nature of the educational software systems with which it presently uses the mark "I Can Learn" and with which it intends to use the mark ICL. Mr. Lee states that applicant's training system is used in the educational field, mostly in middle and high schools, to instruct students, particularly, slower students, in subjects such as algebra and English. The complete system includes computer hardware which is obtained from third-party vendors, a video decompression board, and software, the latter two being installed by applicant. An entire

classroom is equipped with the computer systems, but the software is geared to go at the pace of each individual child, and is capable of defaulting to the learning style which best suits that child. Mr. Lee testifies that the software has been highly successful since being tested in Louisiana in the '94-'95 school year and is being expanded to cover not only other curriculum but also apprenticeship programs in various trades. The products are presently purchased by school administrators, but Mr. Lee stated that there was the possibility that companies such as Blockbuster Videos might purchase the educational software for rental purposes.

Before considering the issue of likelihood of confusion, we direct our attention to applicant's counterclaim for cancellation in whole of opposer's Registration No. 941,672. Applicant contends that all of the services listed in this registration are services which are necessary to the sale of opposer's goods and thus are not subject to an independent service mark registration. Applicant relies, for a large part, upon the response given by opposer during discovery that its services "are intended primarily in support of opposer's equipment and software products." (Interrogatory No. 4).

In response, opposer argues that since the registration is over five years old, the only potential ground for

cancellation would be abandonment, which applicant has failed to allege, much less prove. Opposer argues that applicant's allegation that opposer's services are only ancillary to the sale of its computers and computer programs is not only not a ground for cancellation under Section 14 of the Trademark Act, but also is contradicted by opposer's evidence of the separate value of these services to opposer and the separate payment by customers for the same.

The only potential grounds for cancellation of a registration over five years old are specifically listed in Section 14(c) of the Trademark Act. While abandonment is one such ground, the qualification of a business activity as a separately registrable service is not. Furthermore, although applicant initially set forth its counterclaim in terms of nonuse or abandonment, the basis upon which applicant is actually seeking to cancel opposer's registration is strictly limited to evidence which applicant contends shows that opposer's services are mandatory to the sale of its goods.

As such, applicant's counterclaim for total cancellation is fatally defective, being based on a ground not available under Section 14(c), and is dismissed with prejudice.<sup>6</sup>

---

<sup>6</sup> As an aside, in *In re Otis Engineering Corp.*, 217 USPQ 278, 280 (TTAB 1982) the Board stated that the fact that the services in question are limited to the party's own equipment is not

Accordingly, opposer's ownership of valid and subsisting registrations for its pleaded mark is no longer at issue, and the registrations may be relied upon for purposes of establishing priority. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In applicant's counterclaim for partial cancellation, or restriction, under Section 18 of the Trademark Act, of each of opposer's pleaded registrations, applicant seeks to limit the goods and services as follows (proposed restrictions underlined):

Computer hardware, i.e., series processors, terminals, and disc storage units; all for use in the fields of office automation and retailing.

Computer programs pertaining to retailing, desktop publishing, word processing, spreadsheets, and office networking recorded on machine-readable tapes, cards, or discs sold as a unit with publications containing specifications or descriptions of computer programs; and forms with visually readable program information recorded thereon; all for use in the fields of office automation and retailing.

Computer engineering services in the fields of office automation and retailing.

Computer programming services in the fields of office automation and retailing.

Training personnel of users of computers in the operation and/or programming of computers with software

---

determinative of registrability, so long as bona fide non-mandatory customer services are provided in connection with the sale of the goods. In the absence of evidence to the contrary, we see no reason to view opposer's services as other than non-mandatory services provided as an accommodation or extra value to its customers.

pertaining to retailing, desktop publishing, word processing, spreadsheets, and/or office networking; all in the fields of office automation and retailing.

Applicant maintains that such restrictions would reflect opposer's actual fields of use of its mark and would eliminate any likelihood of confusion as a result of the concurrent use of the parties' marks. Opposer, on the other hand, argues that these restrictions would "emasculate" its registrations and, even then, would not eliminate the likelihood of confusion between opposer's use of its house mark ICL for its goods and services and applicant's use of ICL for its training system.

As set forth in Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266, 1272 (TTAB 1994), the Board will only exercise its authority under Section 18 of the Trademark Act if the person seeking restriction of a registration alleges and proves that the likelihood of confusion will be avoided if the registration is so restricted. While the party seeking the restriction need not plead and prove a specific ground for cancellation, the Board will only invoke its authority under Section 18 if the proofs show that the restriction is equitable and appropriate.

Thus, we look first to the factors which must be considered in determining the likelihood of confusion and the evidence of record as it relates thereto. See In re



duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Insofar as the similarity of the marks of the parties is concerned, no distinction can be made. They are identical. We do not agree with applicant that the connotations of the mark ICL are different when used by the two parties. Since registration is sought for ICL alone, without any additional wording which might lead consumers to associate ICL with "I Can Learn," rather than International Computers, Limited, there is no basis for assuming that such a connotation will be obvious to potential purchasers of applicant's training system.

The second factor to be taken under consideration is the similarity or dissimilarity of the goods and services involved. As a general principle, the greater the degree of similarity of the marks, the lesser is the degree of similarity required of the goods and services on which they are being used to support a holding of likelihood of confusion. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983) and the cases cited therein. Moreover, it is well established that in making this comparison we must view applicant's goods as set forth in the identification of goods, and in the absence of any limitations, take under consideration all the normal channels of trade and reasonable end products for these

goods. See *CBS Inc, v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). In addition, an application with an identification of goods having no restrictions on trade channels cannot be limited on the basis of evidence presented at trial as to actual channels of trade or type of purchasers. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Opposer argues that there is nothing in the identification of applicant's goods which limits either applicant's computer hardware or its software. Instead, according to opposer, the only limitation is as to the end use of the hardware and software, i.e., "for use as an educational classroom aid and independent self-testing and learning tool for students", the same purpose for which opposer's computers and software are used in opposer's training programs.

Applicant, on the other hand, contends that if opposer's registrations were restricted to the actual fields of use or channels of trade, any likelihood of confusion between the goods and services of the parties would be eliminated. In the alternative, applicant argues that, even without such limitations, it is inherent in applicant's identification of goods that its goods are instructional products purchased by school systems, in contrast to

opposer's business products which have been shown to be for use in the fields of office automation and retailing.

Applicant further argues that the training provided by opposer is brief and only with respect to the operation of computers.

The problem with applicant's analysis is that the identification of goods in its application is not specific as to the type of training that is being provided to the students by means of the "classroom aid" or "learning tool" which consists of "hardware and software." We cannot distinguish between opposer's training of personnel ("students") in the operation and/or programming of computers (which requires both computer hardware and software) and applicant's training system. Moreover, even if opposer's goods and services were restricted in the manner sought by applicant in its counterclaim, this does not eliminate the fact that applicant's training system, as presently identified, would encompass training for these limited purposes. Although Mr. Lee stated that using applicant's software for teaching a subject such as word processing would be "like using the NASA Space Program to fly a kite" (Lee at 55), there is no limitation in the

identification of applicant's goods which would preclude use of its software for this purpose.<sup>7</sup>

Looking to the channels of trade, we find the same deficiency in applicant's identification of its goods. Regardless of the testimony of Mr. Lee as to the actual purchasers of applicant's training system, there is no restriction of the channels of trade for applicant's goods to other than the normal channels of trade for a training system, which would clearly not be limited to school systems. In fact, applicant itself has introduced testimony to the effect that its sales might be expanded to stores such as Blockbuster Videos, a commercial enterprise. Moreover, applicant has acknowledged that, even within the school system channel of trade, competitive educational software products are being sold by companies such as IBM and Apple, which also sell computers similar to opposer's. Thus, no distinction can be made between the goods and services of the parties on the basis of channels of trade. Even if opposer's registrations were restricted to the

---

<sup>7</sup> Although applicant, in its reply brief, proffers the addition of the phrase "for use in the field of education" to its identification, this potential restriction has not been tried by the parties and thus will be given no consideration. See Eurostar, supra, at 1272. Furthermore, it would appear that any type of training might be encompassed by the word "education."

channels of trade specifically described in its testimony, the potential for overlap remains, in the absence of specific limitations of applicant's training systems in terms of subject matter and areas of use.

Of the remaining relevant duPont factors, we find no factor which weighs in applicant's favor. Insofar as purchasers are concerned, there is no limitation in applicant's identification of goods which would rule out the ordinary purchaser of computer hardware and software. Even if its goods were restricted to costly systems purchased by sophisticated buyers, this would not ensure against the likelihood of confusion. The potential still exists for the same purchasers to come into contact with the computer products of both parties, all bearing the mark ICL. Moreover, applicant has made no evidence of record of third-party use of similar marks for similar goods which might lead to a more discriminating scrutiny on the part of these purchasers.

Accordingly, we find that use by applicant of the mark ICL for the goods recited in its application will result in the likelihood of confusion with opposer's use of the identical mark for its computer products and services. Furthermore, the Board will not exercise its authority to restrict opposer's registrations under Section 18 of the

---

**Opposition No. 91912**

Trademark Act, since applicant has failed to prove that the likelihood of confusion would be avoided by these restrictions.

Decision: Applicant's counterclaim for cancellation of opposer's pleaded registrations in whole or in part is dismissed with prejudice. The opposition is sustained and registration is refused to applicant.

R. L. Simms

C. E. Walters

H. R. Wendel  
Trademark Administrative Judges,  
Trademark Trial and Appeal Board